IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.:	09/709,772
Filing Date:	November 8, 2000
Inventor(s):	Stephen Christopher Gladwin
Group Art Unit:	2614
Examiner Name:	Woo, Stella L
Customer No.:	27160
Title:	Structure and Method for Selecting, Controlling and Sending Internet-Based or Local Digital Audio to an AM/FM or Audio Amplifier

Confirmation No.: 3933

Applicant's Brief On Appeal

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Real Party In Interest

The real party in interest is AOL MusicNow LLC by way of an assignment from the inventors, Stephen Christopher Gladwin, Depeng Bi, Jeffrey Jonathon Spurgat and Michael Cortopassi to Full Audio Corporation, recorded on reel/frame 011776/0610, a change of name from Full Audio Corporation to MusicNow, Inc. , recorded on reel/frame 015147/0733, an assignment from MusicNow, Inc to Mayland LLC , recorded on reel/frame 015341/00007, an assignment from MusicNow LLC (F/K/A Mayland LLC) to MN Acquisition LLC recorded on reel/frame 018471/0977 and an assignment from MN Acquisition LLC to AOL MusicNow LLC, recorded on reel/frame 018480/0021.

Related Appeals and Interferences

There are no other appeals or interferences known to the Appellant or the Appellant's representative, which are believed to directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status Of Claims

Claims 1-3, 7 and 8 are pending. Claims 4-6 have been canceled. Claims 1-3, 7 and 8 stand rejected under 35 USC § 103(a) as being patentable over Janik US Patent Application Publication No. US 2005/0113946 A1("the Janik publication") in view of Margulis US Patent No. 6,263,503 ("the Margulis patent").

Status Of Amendments

An Amendment pursuant to MPEP § 1206 was filed on September 2, 2008 in order to simplify the issues on appeal. The amendment was filed subsequent to a final rejection. The Applicant is unaware as of the filing of this Brief whether the Amendment was entered. The claims as currently amended are included in Appendix A.

Summary Of Claimed Subject Matter

Claim 1, the only independent claim, recites a system for enabling digital audio data files from a host computer to be played on a remote conventional audio device. The Boards attention is respectfully directed to page 4 of the specification and Fig. 1 which illustrates a host computer 100 connected to the Internet 101. As shown, the host computer 100 is configured to receive streamed audio content 111 and may include stored digital audio files 112. The claimed system also includes a playback system including a remote base station 200. As shown, the base station is operably connected to the host PC by way of a USB cable 103. The base station 200 is also coupled to one or more conventional playback devices, such as an FM radio 106 and a stereo 105. said base station configured to receive said digital data files from said host PC 100 and convert said digital data files 111, 112 to a predetermined format compatible with one or more conventional playback devices.

The base station 100 is configured to receive digital data files 111,112 from the host computer 100 in a predetermined format and convert those digital data files to a format compatible with the playback devices 105, 106 before transmitting the digital files to the playback devices. 105, 106.

As indicated on page 4 of the specification, the base station 100 may broadcast to a ***receiver*** or a repeater 240. The Board's attention is respectfully directed to Page 4 , line 27 of the specification.

Grounds of Rejection to be Reviewed on Appeal

I. Whether claims 1-3, 7 and 8 are unpatentable under 35 USC § 112, first paragraph, for failing to comply with the written description requirement

II. Whether claims 1-3, 7 and 8 are unpatentable under 35 USC § 103(a) over Janik US Patent Application Publication No. US 2005/0113946 A1("the Janik publication") in view of Margulis US Patent No. 6,263,503 ("the Margulis patent").

Argument

I. The Examiner's rejection of Claims 1-3, 7 and 8 under 35 U.S.C. 112, first paragraph for failing to comply with the written description requirement should be reversed.

It is respectfully submitted that the Examiner's rejection of Claims 1-3, 7 and 8 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement should be reversed because the subject matter of Claim 1 . An Amendment pursuant to MPEP § 1206 was filed on September 2, 2008 to place the Application in better condition for Appeal. It is respectfully submitted that the amendment should overcome the rejection under 35 USC § 112. Specifically, the claims now recite that the base station converts the digital data files received from the host PC to converted digital data files transmits the converted digital data files to the conventional playback devices. It is respectfully submitted that the amendment is fully supported by the specification on page 5, lines 5-22. Accordingly, it is respectfully submitted that this rejection is overcome. The Board is respectfully requested to reverse the Examiner on this issue.

II. The Examiner's rejection of Claims 1-3, 7 and 8 under 35 U.S.C. 103(a) as being unpatentable over the Janik publication and the Margulis patent should be reversed.

It is respectfully submitted that the rejection must be reversed because the Janik publication does not qualify as prior art under 35 § 102. Moreover, it is also submitted that the rejection cannot be supported based upon the Margulis patent alone.

The Janik publication is not prior art

The present application is a continuation-in-part of commonly-owned U.S. Patent Application No. 09/649,981, filed on August 29, 2000 ("the parent application") , which claims the benefit of and priority to U.S. Provisional Patent Application No. 60/151,714, filed on August 31, 1999 ("the provisional application"). It is respectfully submitted that the pending claims are supported by the parent application as well as the provisional application. As such, the effective filing date of the present application is August 31 1999. The Janik application claims the benefit of a provisional application no. 60/230,530, filed on September 1, 2000. As such, the earliest effective date for the Janik application is September 1, 2000. Based on the above, it is respectfully submitted that the Janik application is not prior art within the meaning of 35 U.S.C. § 102.

Whether the claims on appeal are entitled to the priority of the provisional application depends on whether the claims on appeal are supported by the specification of the provisional application. If so, the claims on appeal are entitled to the August 31, 1999 priority date. Other

than purely semantic differences, it is respectfully submitted that the claims on appeal are supported by the provisional application.

For the convenience of the Board, a claim chart has been prepared for each claim on appeal. For ease of discussion, for claims 1, 7 and 8, each element has been numbered with an alpha numeric number. For the additional convenience, the references to the provisional application are provided in terms of column and line numbers of the parent application since the specifications of the parent and provisional applications are identical. The Board is kindly requested to note that the claims herein reflect changes set forth in an Amendment filed pursuant to MPEP § 1206 on September 2, 2008.

	Claims on Appeal	**Support in Provisional Application**
1a	**A system for enabling digital audio data files to be played on a remote conventional audio device, the system comprising:**	**"A system and method that allows a host PC to provide an analog audio signal for a radio or amplifier without interfering with the operation of the host PC. Abstract, lines 1-3.**
1b	**a host PC configured to be connected to the Internet,**	**As shown below, Fig. 1 illustrates a Host PC 26 connected to the Internet.**
1c	**said host PC configured to store digital data files and receive streaming digital data files; and**	**Fig. 1 also shows that the Host PC stores "Digital audio files on local disk" and "Digital Audio from the Internet"**
1d	**a playback system including a base station,**	**The system includes a "PC Adapter "24. The PC adapter 24 is simply a base station for broadcasting the digital files received from the host PC to remote playback devices.**
1e	**said base station remote from said host PC**	**As shown in Fig. 1, the PC Adapter 24 is connected to the Host PC 26 by way of a "USB Connection" and is therefore remote from the Host PC 24.**
1f	**and configured to be operably connected to said host PC**	**As mentioned above, the PC Adapter 24 is connected to the Host PC 26 by way of a "USB Connection." and is therefore operably connected to the Host PC 24.**
1g	**and coupled to one or more conventional playback devices,**	**Again referring to Fig. 1, the PC Adapter 24 is shown connected to a remote device 22 and an AM/FM radio or stereo amplifier and is therefore connected to one or more**

		conventional playback devices.
1h	said base station configured to receive said digital data files from said host PC	The PC adapter 24 connects the host PC 26 over a universal serial bus (USB) port and broadcasts to the AM/FM radio and stereo amplifier 28. This audio data is converted from digital audio data and transmitted from the host PC over USB connection by the PC software as shown in FIG. 5.
1i	and convert said digital data files to a predetermined format compatible with one or more conventional playback devices defining converted digital data files	See 1h above
1j	said base station including a receiver for receiving said digital data files ~~in said predetermined format~~	As mentioned in 1h above, the PC adapter receives digital data files from the host PC 26
1k	and a transmitter for transmitting said converted digital data files to said one or more conventional playback devices.	.The PC Adapter 26 transmits converted digital data files to one or more conventional playback devices.
2	The system is recited in claim 1, wherein said conventional device is a radio.	Fig. 1 illustrates a AM/FM radio 28 connected to the PC Adapter 24
3	The system is recited in claim 2, wherein said radio is an FM radio.	See 2 above.
7a	The system is recited in claim 1, wherein said playback system is configured to receive audio signals from said base station	As mentioned above, the PC Adapter 24 is analogous to the base station in the claims at issue. The playback system receives audio signals from the PC Adapter 24. ("The PC adapter 24 connects the host PC 26 over a universal serial bus (USB) port and broadcasts analog radio data to the AM/FM radio and stereo amplifier 28.Col. 2, lines 41-43).
7b	and provide an audio output suitable for a conventional stereo.	See 7a above
8a	The system is recited in claim 1, further including a remote control device,	The system includes a remote control device 22. ("The remote device 22 (FIG. 2) may have a 160.times.160 graphical display screen and control buttons. This display provides information about available audio content, information about how to select audio content, information about audio content that has been selected and other information. The control buttons are used to select and control audio

		content. As shown in FIG. 3, remote device 22 may connect to the PC adapter 24 over a radio link, for example, a 2-way wireless link. **The remote device 22 may have three buttons and one jogdial. Pressing the middle button brings back the previous screen. Pressing one of the other two buttons causes the content to be saved on host PC 26. Pressing the third button will initiate the purchase of the currently playing audio clip. The jogdial browses the list and pressing its middle button will selects and plays the clip. Col. 2, lines 24-39).**
8b	**remote from said playback system,**	**The remote device 22 is remote from the playback system. See Fig. 1**
8c	**for controlling said transmission of said digital data files to said base station.**	**The remote device controls transmission of the digital files to the PC Adapter 24.**

Based on the above, it is clear that each and every element of the claims at issue is supported by the provisional application. Accordingly, it is respectfully submitted that claims on appeal are entitled to a priority date of the provisional application; namely August 31, 1999 or alternatively the filing date of the parent application, namely August 29, 2000. In either case, the Janik publication cannot be a reference within the meaning of 35 USC § 102 since its earliest effective filing date is September 1, 2000.

The Applicant would like to point out that the base station, recited in the claims on appeal, i.e. "base station 200" in Fig. 1 of the instant application ,corresponds to the PC Adapter 24 in the parent application. In particular, the Applicant would also like to respectfully point out that the only difference between the devices is semantic. Both are coupled to a remote PC and both broadcast to remote playback devices. Thus, it should be clear that the PC Adapter as used in the parent application is a base station in the same sense as the term base station is used in the instant application.

Given that the Janik publication is not a reference, it is respectfully submitted that the rejection under 35 USC § 103 cannot stand on the Margulis reference alone. Indeed, the Examiner cited the Margulis patent for teaching the use of a repeater. The Margulis patent does not disclose nor does the Examiner contend that the Margulis patent teaches, discloses or suggests all of the elements of the claims on appeal. As such, the Board is respectfully requested to reverse this rejection.

Conclusion

It is respectfully submitted that The Board is respectfully requested to reverse the rejections of all claims by the Examiner.

Respectfully Submitted,

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APPENDIX A
CLAIMS ON APPEAL

1. A system for enabling digital audio data files to be played on a remote conventional audio device, the system comprising:

a host PC configured to be connected to the Internet, said host PC configured to store digital data files and receive streaming digital data files; and

a playback system including a base station, said base station remote from said host PC and configured to be operably connected to said host PC and coupled to one or more conventional playback devices, said base station configured to receive said digital data files from said host PC and convert said digital data files to a predetermined format compatible with one or more conventional playback devices defining converted digital files, said base station including a receiver for receiving said digital data files and a transmitter for transmitting said converted digital data files to said one or more conventional playback devices

2. The system is recited in claim 1, wherein said conventional device is a radio.

3. The system is recited in claim 2, wherein said radio is an FM radio.

4. (Cancelled).

5. (Cancelled).

6. (Cancelled).

7. The system is recited in claim 1, wherein said playback system is configured to receive audio signals from said base station and provide an audio output suitable for a conventional stereo.

8. The system is recited in claim 1, further including a remote control device, remote from said playback system, for controlling said transmission of said digital data files to said base station.

APPENDIX B
EVIDENCE APPENDIX

None

APPENDIX C
RELATED PROCEEDINGS APPENDIX

None